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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/551,921

Applicant(s)

LECOMTE, DANIEL

Examiner

STEVEN KIM

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-30, 32, 33 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-30, 32, 33 and 36-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the amendment filed on July 27, 2009 (hereinafter "Amend0709").

Status of Claims

2. Claims 1-20, 31, 34, and 35 have been previously canceled.
3. Claims 21-30, 32, 33, and 36-44 have been amended.
4. Claims 21-30, 32, 33, and 36-44 have been examined.
5. Claims 21-30, 32, 33, and 36-44 and are pending.

Continued Examination Under 37 CFR 1.114

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 27, 2009 has been entered.

Response to Arguments

7. Applicant's arguments with respect to claims 21-30, 32-33, and 36-44 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

8. Claims 21-23, 24-30, 32-33, and 43-44 are objected to because of the following informalities: the independent claim 21 contains inconsistent punctuation, e.g. semicolon and comma, and punctuation is missing between the producing step clauses. Appropriate correction is required.

Specification

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claims 44 and 27 recite storing the main stream at a distribution site wherein storing the main stream at the distribution site is conditional upon transmission of identifying information by the user. This is not supported in the written disclosure.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 21-23, 24-30, 32-33, and 43-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit

decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

12. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

13. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

14. In this particular case, claims 21-23, 25-30, 32-33, and 43-44 fail prong (1) because the "tie" (e.g. dividing ... using video processing equipment, storing ... in a server) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 21-30, 32-33, and 36-44 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.
17. The independent claims 21 and 36 recite "respective users", "a user", and "the user". The claim is ambiguous since the relationship(s) of recited user(s) are unclear.
18. Similarly, claims 26, 27, 28, 32, 33, 30, 36, and 37 recite ambiguous user(s).
19. Claims 22-30, 32-33, and 37-44 are rejected similarly as each depends on claims 21 or 36.
20. As per claim 37, the claim recites "conditional means of". It is unclear whether the claim is invoking the 35 U.S.C. 112, sixth paragraph since the claim recites "means of" instead of "means for".
21. If, however, the claim element "means of" is to be interpreted as a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function. While the written description contain "conditional mean of" language for accessing the burned DVD, the written descriptions fails to clearly link the disclosed structure, material, or acts to the claimed function.
22. Applicant is required to:
- amend the claims so that the claim limitations will no longer be a means plus function limitation under 35 U.S.C. 112, sixth paragraph; or

- amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function without introducing any new matter (35 U.S.C. 132(a)); or
- state on the record where the corresponding structure, material, or acts are set forth in the written description of the specification that perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

23. Furthermore, it is unclear whether the recited "conditional means of" is an apparatus or merely conditional situation.

24. As per claim 40, the claim recites "automaton/device". It is unclear whether the claim is directed to automaton or device or both.

25. Claim 30 recites "the video stream". There is insufficient antecedent basis for this limitation in the claim.

26. Claim 26 recites "wherein the selection". The independent claim, however, recite "a selected" in line 4 and "a selection" in line 15. It is unclear which selection the claim is referring to.

27. Claim 33 recites "wherein the server is connected to a database in which the processing specific for the respective user processing is associated with the respective user". It is unclear to the person of ordinary skill what "a database in which the processing specific for the respective user processing is associated with the respective

user" is. For the prosecution purpose, the Examiner will interpret as "a database used for processing specific for the user".

28. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed. See *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

29. Claims 21-23, 24-30, 32-33, and 43-44 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

30. The independent claim recites "selected original video", "distributing ... in response to a selection", and "sending ... in response to information received". Hence, the missing steps are: selecting original video, receiving a selection, and receiving information.

31. Claim 28 recites "performing processing specific to a distributor **designated** by the user" without reciting "receiving distributor designation".

32. Similarly, claim 30 recites "obtained from the distributor" without reciting step of obtaining.

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claims 21-30, 32-33, and 36-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,892,900 (hereinafter "Ginter") in view of US Patent Application No. 2002/0413807 (hereinafter "Komatsu").

35. In regards to claims 21 and 36, Ginter discloses distributing the main stream to a user in response to a selection by the user (see Ginter, see Fig. 1 and Fig. 3; Fig. 72B – 72D; col./lines 53/39 -56/65). Ginter further discloses a flexible distribution of electronic content, controlling of the electronic content (see col. 1, lines 9-30), and sending of complementary digital information to the user during viewing of the modified main stream sent to the user on the material support supplied by the distributor (see col. 26, lines 10-43, use of clearinghouse to control the VDE activities; col. 309, lines 1-18, routing of information using two containers; col. 342, lines 21-35, use of two depositories). Ginter further discloses personalizing digital content (see Fig. 5B). Ginter also discloses a modification stage of packaging elements of content into a container (see col. 59, lines 7-67).

36. Ginter, however, does not specifically disclose: dividing content of a selected original video sequence into two parts, a larger part and a smaller part, using video

processing equipment; producing a main stream in a nominal format of the selected original video sequence, wherein the main stream is produced based on said larger part; producing complementary digital information based on said smaller part, wherein the complementary digital information is personalized for respective users and is complementary to the main stream, storing the complementary digital information in a server, and sending the complementary digital information corresponding to the main stream to the user, in response to information received from the user's equipment upon initiation of viewing the main stream, during viewing of the main stream.

37. Komatsu, on the other hand, discloses method comprising:

- dividing content of a selected original video sequence into two parts, a larger part and a smaller part, using video processing equipment (see Fig. 1; ¶0019; ¶0033, content separator that divides a content into insufficient and complementary; ¶0044; ¶0045; ¶0064);
- producing a main stream in a nominal format of the selected original video sequence, wherein the main stream is produced based on said larger part (see Fig. 1; ¶0019; ¶0033; ¶0044; ¶0045; ¶0047; ¶0049; ¶0064);
- producing complementary digital information based on said smaller part, wherein the complementary digital information is complementary to the main stream, wherein the complementary digital information is personalized for respective users and is complementary to the main stream (see Fig. 1; ¶0019; ¶0033; ¶0045; ¶0046; ¶0048; ¶0064);

- storing the complementary digital information in a server (see Fig. 2; ¶0045; ¶0071);
- sending the complementary digital information corresponding to the main stream to the user, in response to information received from the user's equipment upon initiation of viewing the main stream, during viewing of the main stream (see ¶0036; ¶0037; ¶0041; ¶0048; ¶0058; ¶0074-¶0079).

38. Ginter and Komatsu are analogous art since they are from the same field of endeavor of protecting/controlling content usage. It would have been obvious to one of ordinary skill in the art to combine the teachings. The motivation for doing so would have been to allow flexible and additional layer of protecting the digital content usage (see Komatsu, ¶0090).

39. In further regards to claim 36, Komatsu discloses a video bank, analysis device, and at least one distribution equipment (see Fig. 1 - Fig. 4).

40. As per claim 22 and 23, Ginter also discloses storing digital information that identifies a distributor, wherein the main stream contains digital information identifying the distributor (see col./line 37/15-38/35, watermarking; col. 304, lines 17-19).

41. As per claims 24 and 43, Ginter further discloses recording the main stream at the distribution site on a standard physical support medium, wherein the standard physical support medium is a DVD disk (see col. 3; lines 22-26, delivery means

including optical/magnetic disk, col. 6-21; col. 62, lines 31-50). Komatsu also discloses recording the main stream on a standardized support medium (see ¶0070).

42. As per claim 25, the prior art discloses claim 43 elements as described above. Ginter further discloses reading the standard physical support medium with an apparatus comprising a user identifier (see col. 42, lines 35-40; col. 43, lines 10-14; col. 45, lines 57-62).

43. As per claim 30, the prior art discloses claim 43 elements as described above. Ginter further discloses forwarding the standard physical support medium to the user by a distributor (see col. 3, lines 21-25; Fig. 2 and Fig. 2A). Komatsu discloses during use of the standard physical support medium obtained from the distributor, sending the complementary digital information as viewing of the video stream progresses (see ¶0070; ¶0036; ¶0037; ¶0041; ¶0048; ¶0058; ¶0074-¶0079).

44. As per claim 26, the prior art teaches claim 21 as described above. Ginter further discloses wherein the selection is received from a personal terminal of the user communicating via a public telecommunication network a public telecommunication network (see Fig. 1 and Fig 3; col. 307, lines 5-10).

45. As per claims 27 and 44, the claims are directed to further step of storing the main stream at a distribution site wherein the storing is conditional upon transmission of identifying information by the user. The prior art teaches flexible distribution of electronic content and controlling the use of the content (see Ginter, col. 1, lines 9-30, Fig. 77, Fig. 78; Komatsu, ¶¶0090). The prior art also teaches identifying user information, e.g. payment (see Ginter, Fig. 77 and Komatsu, ¶¶0075). Hence, a predictable result is to store the content in the distribution site, for distribution, conditional upon authenticating the user for payment.

46. As per claims 28 and 29, Ginter discloses performing processing specific to the distributor designated by the user in the user's selection (see Fig. 5B; Fig. 26A; Fig. 78). Furthermore, Komatsu discloses performing processing specific to the distributor wherein the server is connected to a database (see Fig. 3) in which the processing specific to the distributor is associated with an identifier of the distributor to which a resulting main stream is transmitted (see ¶¶0077 - ¶¶0078). Ginter also discloses wherein the server is connected to a database in which the processing is associated with an identifier of the distributor to which a resulting main stream is transmitted (see col. 8, lines 1-7; col. 9, lines 24-28; col. 12, lines 11-13; col. 63, lines 27-54).

47. As per claim 32, Ginter discloses wherein at least one of said producing the main stream or said producing complementary digital information comprises performing processing specific for a respective user who selects the original video sequence (see

Fig. 5B; Fig. 26A; Fig. 78). Furthermore, Komatsu discloses wherein at least one of said producing the main stream or said producing complementary digital information comprises performing processing specific for a respective user (see ¶0034; ¶0036).

48. As per claim 33, Ginter discloses wherein the server is connected to a database in which the processing specific for the respective user is associated with the respective user (see col. 8, lines 1-7; col. 9, lines 24-28; col. 12, lines 11-13; col. 63, lines 27-54). Furthermore, Komatsu discloses wherein the server is connected to a database in which the processing specific for the respective user is associated with the respective user (see ¶0034; ¶0036; Fig. 2).

49. As per claim 30 and 43, Ginter discloses use of physical support, i.e. disk, in distributing content (see col. 3, lines 21-25). Dawson discloses sending of complementary digital information as viewing of the video stream progresses, which portion of complementary digital information is stored temporarily in an input memory that is a volatile memory (see col. 2, lines 42-50, reconstruction of the original video).

50. As per claim 32, Ginter discloses wherein the stage of modifying the original video sequence corresponds to a processing specific for each user identified during the selection stage (see limitations in claim 21, user selecting necessarily anticipates this limitation).

51. As per claim 33 Ginter discloses wherein the server is connected to a database in which each specific processing is associated with a user (see col. 8, lines 1-7; col. 9, lines 24-28; col. 12, lines 11-13; col. 63, lines 27-54).

52. As per claim 37, Ginter further discloses a video server comprising a video bank and at least one piece of distribution equipment comprising a DVD burner and a printer (see Fig. 2; col. 2, lines 19-32; col. 6, lines 55-63, col. 22, lines 26-55; Fig. 7 - Fig. 10) .

53. As per claims 37 and 39, Ginter further discloses a DVD burner, a means of accessing a burned DVD, and a printer (see Fig. 2; col. 2, lines 19-32; col. 6, lines 55-63, col. 22, lines 26-55; Fig. 7 - Fig. 10) .

54. As per claim 38, Ginter further discloses wherein the at least one piece of distribution equipment and the server are integrated in a single system (see col. 281, lines 23-30). Furthermore, the claim is representative of making integral. See *In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961).

55. As per claim 40, Ginter also discloses a device for distribution of recording supports (see Fig. 2; col. 2, lines 19-32; col. 6, lines 55-63, col. 22, lines 26-55; Fig. 7 - Fig. 10).

56. As per claim 41, Ginter discloses wherein the at least one piece of distribution equipment is coupled to receive from the server at least a main stream and is configured to store the main stream (see Fig. 2; col. 2, lines 19-32; col. 6, lines 55-63, col. 22, lines 26-55; Fig. 7 - Fig. 10).

57. As per claim 42, Ginter further discloses a recording device to record the main stream onto a standard physical support medium (see Fig. 2; col. 2, lines 19-32; col. 6, lines 55-63, col. 22, lines 26-55; Fig. 7 - Fig. 10).

58. Additionally, claims 36-42 are directed to a system specifically to a video server and distribution equipment. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

Conclusion

59. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 7,382,969 discloses dividing video content into two, transmitting the split contents in a separate channel, and combining the two during viewing; US Patent Application No. 2002/0108035 discloses splitting file into two and

combining at destination device; US Patent Application No. 2003/0135464 discloses distribution of electronic content; US Patent 6,308,887 discloses super-kiosk.

60. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

61. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

62. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./
Examiner, Art Unit 3685

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621

